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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,993	12/11/2003	Kathryn M. Spurgeon	58980US002	8280

32692 7590 05/11/2010

3M INNOVATIVE PROPERTIES COMPANY
PO BOX 33427
ST. PAUL, MN 55133-3427

EXAMINER	
VARGOT, MATHIEU D	

ART UNIT	PAPER NUMBER
1791	

NOTIFICATION DATE	DELIVERY MODE
05/11/2010	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KATHRYN M. SPURGEON,
PETER F. CULLEN, PATRICK A. THOMAS,
CHARLIE T. SOBOTTKA, S. LANCE BRIDGES,
and ROBERT S. MOSHREFZADEH

Appeal 2009-005141
Application 10/732,993
Technology Center 1700

Decided: May 07, 2010

Before BEVERLY A. FRANKLIN, KAREN M. HASTINGS,
and JEFFREY R. ROBERTSON, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seeks our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1-33. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

Claim 1 is illustrative:

> 1. A method of forming an optical film comprising:
>
> extruding a first material to form a first film in a molten state;
>
> extruding a second material to form a second film in a molten state;
>
> maintaining the first and second films in molten states;
>
> bringing the molten first film proximate the molten second film;
>
> patterning the molten second film to form a plurality of structures, the structures defining a plurality of cavities therebetween; and
>
> solidifying the molten second film.

Appellants appeal the following rejections:

1) Claims 1, 4, 8, 10, and 12 under 35 U.S.C. § 102(b) as anticipated by Karszes (US 6,060,003, issued May 9, 2000).

2) Claims 1, 4, and 8-33 under 35 U.S.C. § 103(a) as unpatentable over Karszes.

3) Claims 2, 3, and 5- 7 under 35 U.S.C. § 103(a) as unpatentable over the combined prior art of Karszes and Fitzpatrick (US 4,701,019, issued Oct. 20, 1987).

ISSUES

Did the Examiner err in finding that Karszes describes an extruded molten first film and an extruded molten second film as required by the steps of claim 1?

We answer this question in the affirmative.

Did the Examiner err in determining that the steps of claim 1 are obvious over the teachings of Karszes?

We answer this question in the negative.

PRINCIPLES OF LAW

Anticipation

"[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations *arranged or combined in the same way as recited in the claim*, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102." *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008) (emphasis added). In order to anticipate, a reference must identify something falling within the claimed subject matter with sufficient specificity to constitute a description thereof within the purview of § 102. *In re Schaumann*, 572 F.2d 312, 317 (CCPA 1978).

Obviousness

An improvement in the art is obvious if "it is likely the product not of innovation but of ordinary skill and common sense." *KSR Int'l. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007). Therefore, in making a determination of obviousness, one must consider the teachings of the reference in light of the

knowledge and capabilities of those of ordinary skill in the art. *See In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) ("[A] prior art reference must be 'considered together with the knowledge of one of ordinary skill in the pertinent art.'"); *In re Sovish,* 769 F.2d 738, 743 (Fed. Cir. 1985) (skill is presumed on the part of the artisan, rather than the lack thereof).

ANALYSIS

with Factual Findings

Appellants argue that the Examiner has not shown how Karszes teaches a molten first film and a molten second film as required by claim 1 since Karszes merely discloses that the resins contact one another in "black box" 22 (Br. 6). We agree.

The Examiner acknowledges that "the point of contact of the molten materials would *most probably* be that of a film in the black box" (Ans. 8, emphasis provided). It is well established that a rejection based upon inherent anticipation can not be established by possibilities or probabilities. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). The Examiner also characterizes the black box of Karszes as an "*admittedly ambiguous* disclosure" (Ans. 9, emphasis added), which further highlights that Karszes does not describe the method steps therein with sufficient specificity to anticipate the claims.

On the other hand, with respect to the rejections based on obviousness, we adopt the factual findings and reasoning of the Examiner (Ans. 5-8) and add the following primarily for emphasis.

Appellants' Specification states that a "co-extrusion die" is used for "the simultaneous extrusion of a two-layer film" (Spec. 5: 23-25) which is extruded proximate a nip roll (Spec. 6: 9-12). Similarly, Karszes teaches the

"molten co-extruded material 49, which comprises three layers . . . is extruded into a nip" (col. 4, ll. 16-18).

Appellants' contentions that there is no teaching or suggestion in Karszes regarding extrusion of individual films (*e.g.,* Br. 8) are of no persuasive merit, since Appellants have not challenged the Examiner's finding that it is

> conventional in the art to employ separate extruders for molten materials to form individual films and then combine the films in a downstream die to form a composite film . . . or to extrude molten materials separately through different film forming dies and then combine the films so that one is brought proximate to the other and these methods would be obvious equivalents to what is taught in Karszes"

(Ans. 5; *generally* Br.)

It is also undisputed that Karszes "desires to laminate the materials together" to result in a layered product without any mixing of those layers (Ans. 9; *generally* Br.).[1] Accordingly, the evidence as a whole supports the Examiner's conclusion of obviousness.

We therefore agree with the Examiner's conclusion that using a conventional extrusion technique to form the three-layered film that comes out of the black box of Karszes would have been nothing more than using a known layered film technique in accordance with its known function for the predictable result of creating a co-extruded layered product. *See KSR*, 550 U.S. at 416 ("The combination of familiar elements according to known

[1] No Reply Brief has been filed.

methods is likely to be obvious when it does no more than yield predictable results.").

Appellants have not presented any further arguments regarding the § 103 rejection of claims 2, 3, 5, and 7 over the combined prior art of Karszes and Fitzpatrick (Br. 9).

Accordingly, on the record before us, we sustain the § 103 rejections of claims 1-33 as maintained by the Examiner.[2]

DECISION

We reverse the Examiner's § 102 rejection.

We affirm the Examiner's § 103 rejections.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

ORDER

AFFIRMED

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3M INNOVATIVE PROPERTIES CO.
P O BOX 33427
ST. PAUL, MN 55133-3427

[2] Only those arguments actually made by Appellants have been considered in this decision. Arguments which could have made but Appellants chose not to make have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2008).